Union Oil Co. of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP § 2131 (*emphasis added*).

Independent Claim 1 is a method of providing access privileges to records of members of a community reciting the following:

> "**storing an assignment of a member of a community to a first position in the community to generate a first relationship;**
> **automatically providing a manager of the first position with access privileges to records of the member based on the first relationship;**
> **storing an additional assignment of the member to a second position in the community to generate a second relationship; and**
> **during pendency of the additional assignment, automatically providing a manager of the second position with disparate access privileges to records of the member based on the second relationship.**"

Applicant respectfully submits that the rejection of Claim 1 is improper for at least the reason that *Howell* does not disclose, teach or suggest each and every limitation of the claimed invention. For example, *Howell* does not disclose either "**storing an assignment of a member of a community to a first position in the community to generate a first relationship,**" or "**storing an additional assignment of the member to a second position in the community to generate a second relationship,**" as recited by Claim 1. Assigning a member of the community to a position in the community (e.g., assigning an employee to a position in a business, as in one embodiment of the present invention) does not equate with assigning a user access to a specific object or objects either directly or through an affiliated group or user, as suggested by the Examiner. *Howell* at no point discloses assigning a member to a position in a community or the storing of such an assignment.

6

In addition, *Howell* does not disclose "**automatically providing a manager of the first position with access privileges to records of the member based on the first relationship**," as further recited by Claim 1. Although *Howell* discloses providing access by users to certain objects, nowhere does it disclose providing a manager of a position with access to the records of a member assigned to that position.

Moreover, *Howell* does not disclose basing access privileges on relationships generated by storing assignments of members to positions in the community as recited by the combination of the first two elements of Claim 1. As set out in the present application, basing access privileges on relationships generated by storing assignments of members to positions allows access privileges to be automatically updated upon reassignment of members. Thus, time and resources necessary to manage the system are reduced. Because *Howell* does not store assignments of members to positions or base access privileges on a relationship generated by storing the assignments, specific access files need to be updated each time members are added, deleted, or reassigned.

Finally, *Howell* does not disclose "**automatically providing a manager of the second position with disparate access privileges to records of the member based on the second relationship**," as recited by Claim 1. As discussed above, *Howell* does not disclose providing a manager of a position with access to the records of a member assigned to that position. Therefore, it follows that *Howell* does not disclose providing "**disparate access privileges**" to different managers based on their relationship with that member and the position or positions to which that member is assigned. To further clarify the Applicant's position, the following excerpt is provided from the present application as one example of such "**disparate access privileges**":

> "In the community 120, exemplary member 128 may be administratively assigned to a position 130 of an organization 132 and be work assigned to an additional position 134 of another organization 136. Thus, the member 128 may report to manager

position 138 of organization 132 and manager position 140 of organization 136. In this embodiment, manager position 138 may have administrative responsibility for the member 128. Manager position 140 may have only work assignment responsibility for the member 128. Accordingly, manager positions 138 and 140 may have disparate access privileges to records of the member 128 consistent with each manager's responsibilities toward the member 128.

In a particular embodiment, manager 138 in the administrative relationship with the member 128 may have full administrative access privileges to records of the member 128. Manager 140 in the work assignment relationship with the member 128 may have limited access privileges to records of the member 128. The limited access privileges may be a subset of the access privileges of the administrative manager 138." (page 22, lines 5-25)

Applicant respectfully submits that *Howell* in no way discloses providing any type of **"disparate access privileges"** to managers of different positions in a community to which a member is assigned. Accordingly, Claim 1 is not anticipated by the cited art. Therefore, Applicant respectfully submits that this rejection should now be withdrawn.

Claim 2 that depends from independent Claim 1 is also not anticipated by *Howell* because it includes the limitations of Claim 1 and adds additional elements that further distinguish *Howell*. Therefore, Applicant respectfully requests that the rejection of Claim 2 be withdrawn.

Additionally, Claim 2 recites the method of Claim 1, wherein **"the manager of the second position has limited access privileges to records of the member."** As discussed above in relation to Claim 1, *Howell* does not disclose providing a manager of a position with access

to the records of a member assigned to that position. Therefore, the reference also does not disclose limiting the access privileges of a manager of a second position to the records of a member assigned to that position. Accordingly, Claim 2 is not anticipated by the cited art. Therefore, Applicant respectfully submits that this rejection should now be withdrawn.

Independent Claim 7 is a method of storing relationships between members of a community in a computer system reciting:

> "storing a first assignment of a first member of a community to a first manager position in the community;
>
> storing a second assignment of a second member of the community to a second manager position in the community; and
>
> storing a third assignment of the first manager position to the second manager position."

The rejection of Claim 7 is improper for at least the reason that *Howell* does not disclose, teach or suggest each and every limitation of the claimed invention. Applicant respectfully submits that *Howell* does not disclose "a method of storing relationships between members of a community in a computer system" that includes the steps of "storing a first assignment of a first member of a community to a first manager position in the community; [and] storing a second assignment of a second member of the community to a second manager position in the community," as recited in Claim 7. Nowhere does *Howell* disclose storing the assignment of a member to a manager position. The passage from *Howell* that is cited by the Examiner discusses the storing of objects on storage devices so that the objects may be accessed by users that have access privilege. Applicant respectfully submits that neither this passage, nor any other portion of *Howell*, discloses or relates to assigning members of a community to positions in the community or storing such assignments. Likewise, *Howell* also fails to disclose that one manager position may be assigned to another manager position, as further recited by

Claim 7. Accordingly, Claim 7 is not anticipated by the cited art. Therefore, Applicant respectfully submits that this rejection should now be withdrawn.

Claims 8 and 9 that depend from independent Claim 7 are also not anticipated by *Howell* because they include the limitations of Claim 7 and add additional elements that further distinguish *Howell*. Therefore, Applicant respectfully requests that the rejection of Claims 8 and 9 be withdrawn.

Claim 8 recites the method of Claim 7, further comprising the step of "**automatically providing the first manager position with at least a portion of the access privileges of the second manager position to records of members of the community reporting to the second manager position.**" Although *Howell* does disclose providing access privileges to users, it does not disclose automatically providing a first manager access to the records of members reporting to a second manager. The reference also does not discuss the relative levels of access of two managers managing a common member. Accordingly, for this additional reason, Claim 8 is not anticipated by the cited art. Therefore, Applicant respectfully submits that this rejection should now be withdrawn.

Likewise, *Howell* also does not disclose "**automatically providing the first manager position with full access privileges of the second manager position to records of members of the community reporting the second manager position,**" as recited in amended Claim 9. Therefore, Applicant respectfully submits that this rejection should now be withdrawn.

Independent Claim 13 is a system for providing access privileges to records of members within a community reciting:

"**a plurality of allowed types of assignments of members of a community to positions in the community;**

a record of assignments of members of the community to positions in the community; and

disparate access privileges to records of a member for
at least two of the allowed types of assignments."

The rejection of Claim 13 is improper for at least the reason that *Howell* does not disclose, teach or suggest each and every limitation of the claimed invention. For example, Applicant respectfully submits that *Howell* does not disclose either "a plurality of allowed types of assignments of members of a community to positions in the community," or "a record of assignments of members of the community to positions in the community," as recited in Claim 13. The assignment of a member of the community to a position in the community (e.g., assigning an employee to a position in a business, as in one embodiment of the invention) does not equate with assigning a user access to a specific object or objects, as suggested by the Examiner. Likewise, a record of the assignments is not disclosed by the *Howell's* description of an "access control list."

Furthermore, Applicant respectfully submits that *Howell* does not disclose "disparate access privileges to records of a member for at least two of the allowed types of assignments," as recited by Claim 13. Because the reference does not disclose assignments of members to positions in the community, it also does not disclose "disparate access privileges" based on the type of assignment. Accordingly, Claim 13 is not anticipated by the cited art. Therefore, Applicant respectfully submits that this rejection should now be withdrawn.

Claims 14 and 15 that depend from independent Claim 13 are also not anticipated by *Howell* because they include the limitations of Claim 13 and add additional elements that further distinguish *Howell*. Therefore, Applicant respectfully requests that the rejection of Claims 14 and 15 be withdrawn.

Of these dependent claims, Claim 14 recites the system of Claim 13, wherein "the allowed assignments include assignments between positions in the community." As discussed above in conjunction with Claim 13, since *Howell* does not disclose assignments of

members to positions, it also does not disclose assignments between positions. Furthermore, contrary to the Examiner's suggestion, the reference's disclosure of an "affiliation with another user or group" that permits "access to an object," has no relation to an "**assignment between positions,**" as recited in Claim 14. Accordingly, Claim 14 is not anticipated by the cited art. Therefore, Applicant respectfully submits that this rejection should now be withdrawn.

Claim 15, as amended, recites the system of Claim 13, wherein "**a temporary assignment of a member to a position is associated with limited access privileges to records of the member.**" The Examiner states that since the reference suggests that access privileges can be assigned and reassigned, that such privileges are temporary. Assuming this to be true for the sake of this discussion, nowhere does *Howell* disclose a temporary *assignment of a member to a position* (e.g., temporary work assignments, as disclosed in one embodiment of the present invention), or the fact that such a temporary assignment may lead to limited access to the records of the member so assigned. Accordingly, Claim 15 is not anticipated by the cited art. Therefore, Applicant respectfully submits that this rejection should now be withdrawn.

SECTION 103(a) REJECTIONS

Claims 3-6 and 10-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Howell*, as applied to claim 1 above, and further in view of *Meyer* (HRMagazine article "Visual guidance system steers Windows-based HRIS", Feb. 1994). Applicant respectfully traverses these rejections.

To defeat a patent under 35 U.S.C. § 103, the claimed *combination* must be obvious. *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 223 U.S.P.Q. 603 (Fed. Cir. 1984). Therefore, it is essential to view the invention as a whole, taking each element into account as well as the advantages, properties, utilities, and results of the invention. *In re Chupp*, 816 F.2d 643, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987). Furthermore, even where an invention is, as a whole, fully disclosed by a combination of prior art elements, such elements cannot be combined to defeat a patent as obvious unless the art teaches or suggests the desirability of making the claim

12

combination. *ASC Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 U.S.P.Q. 929 (Fed. Cir. 1984). Without such independent suggestion, the art is to be considered as merely inviting unguided and speculative experimentation which is not the standard with which obviousness is determined. *Agmen Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200, 18 U.S.P.Q.2d 1016 (Fed. Cir. 1991). Thus, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, U.S.P.Q.2d 1780 (Fed. Cir. 1992).

Claims 3-6 depend from independent Claim 1. For the reasons stated above, independent Claim 1 is in condition for allowance. Therefore Claims 3-6 are also in condition for allowance. Applicant respectfully requests that the rejection of Claims 3-6 now be withdrawn.

Additionally, Claim 3 recites the method of Claim 1, wherein **"the manager of the first position has access privileges to administrative records of the member denied to the manager of the second position."** Applicant respectfully submits that neither *Meyer* nor *Howell*, alone or in combination, disclose, teach or suggest that a member may be assigned to more than one manager, or that one manager may have access to certain records of the member to which the other manager does not have access. Therefore, Applicant respectfully submits that this rejection should now be withdrawn.

Furthermore, Claim 4 recites the method of Claim 1, wherein **"the additional assignment comprises a temporary work assignment."** Applicant respectfully submits that neither *Meyer* nor *Howell*, alone or in combination, disclose, teach or suggest a temporary work assignment, or that access privileges may be based on a temporary work assignment. Therefore, Applicant respectfully submits that this rejection should now be withdrawn.

Claim 10 depends from dependent Claim 8, and Claim 8 depends from independent Claim 7. Claims 11 and 12 depend from independent Claim 7. For the reasons stated above,

13

independent Claim 7 is in condition for allowance. Therefore Claims 10-12 are also in condition for allowance. Applicant respectfully requests that the rejection of Claims 10-12 now be withdrawn.

In addition, Claim 10 recites the method of Claim 8, wherein "**the access privileges provided to the first manager position exclude access privileges of the second manager position to administrative records of members of the community reporting to the second manager position.**" Applicant respectfully submits that neither *Meyer* nor *Howell*, alone or in combination, disclose, teach or suggest that a member may be assigned to more than one manager, or that one manager may have access to certain records of the member to which the other manager does not have access. Therefore, Applicant respectfully submits that this rejection should now be withdrawn.
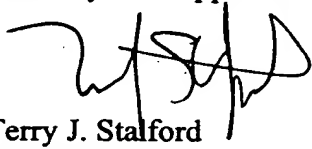
CONCLUSION

Applicant has made an earnest attempt to place this case in condition for immediate allowance. In light of the amendments and remarks set forth above, Applicant respectfully requests reconsideration and allowance of Claims 1-15 as amended.

No fee is believed due with this amendment. If, however, Applicant has overlooked the need for any fee, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

If there are matters which can be discussed by telephone to further the prosecution of this Application, Applicant invites the Examiner to call the undersigned attorney listed below at (214) 953-6477 at the Examiner's convenience.

Respectfully submitted,

BAKER & BOTTS, L.L.P.
Attorneys for Applicant

Terry J. Stalford
Reg. No. 39,522

Send correspondence to:
L. Joy Griebenow, Esq.
Electronic Data Systems Corporation
Legal Affairs, M/S H3-3A-05
5400 Legacy Drive
Plano, Texas 75024
(972) 605-5567

Date: June 18, 1999

DAL01:452093.1